

Serial No. 10/725,159

REMARKS

The Office action dated May 29, 2007 and the cited references have been carefully considered.

Status of the Claims

Claims 4, 7, 9-12, 20, and 21 are pending

Claims 4 and 7 are rejected under 35 U.S.C. § 112, second paragraph, because the claim scope is allegedly uncertain due to the use of the trademark/trade names "Polymer JR 125, Polymer JR 400, Polymer JR 30M, Polymer LR 400, Polymer LR 30M, and Polymer LR."

Claims 4, 7, 9-12, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6,274,133 (hereinafter referred to as "the '133 Patent") in view of US Patent 5,928,606 (hereinafter referred to as "the '606 Patent").

Applicant respectfully traverses these rejections for the reasons set forth below.

Claim Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 4 and 7 are rejected under 35 U.S.C. § 112, second paragraph, because the claim scope is allegedly uncertain due to the use of the trademark/trade names "Polymer JR 125, Polymer JR 400, Polymer JR 30M, Polymer LR 400, Polymer LR 30M, and Polymer LR." Claims 4 and 7 are amended to recite polyquarternium-10, which is the cationic polysaccharide represented by the name "Polymer JR" recited in the original claims. Therefore, this rejection is now overcome.

Claim Rejection Under 35 U.S.C. § 103(a)

Claims 4, 7, 9-12, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the '133 Patent in view of the '606 Patent. Applicant respectfully traverses the rejection of these claims because a combination of the '133 Patent and the

Serial No. 10/725,159

'606 Patent does not teach or suggest all of the limitations of each of claims 4, 7, 9-12, 20, and 21.

To establish a *prima facie* case of obviousness, the prior art references (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2142 (Rev. 5, Aug. 2006). Moreover, even when all the elements are present, an apparent reason to combine the known elements (limitations) in the fashion presently claimed should be made explicit by the fact finder. *KSR Int'l Co. v. Teleflex Inc.*, 2007 U.S. Lexis 4745, 36-37; 127 S. Ct. 1727, 1741 (2007). It can be important to identify the reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does because merely demonstrating that each of the claimed invention's elements was known in the prior art is not sufficient to establish a *prima facie* case of obviousness. *Id.*; see also *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665 (Fed. Cir. 2000).

The '133 Patent discloses cationic cellulosic polymers and general monosaccharides, each performing a separate function. The cationic cellulosic polymers serve to complex with the contact lens surface to prevent the deposition of lipids and to provide a cushioning layer between the contact lens and the ocular surface. Column 5, lines 13-20. The monosaccharides serve as wetting agents. Column 7, lines 20-22.

The '606 Patent discloses a contact lens-disinfecting device, a disinfection treating portion of which is impregnated with a wetting agent which can contain a tonicity agent such as saccharides (e.g., glucose, mannitol). Column 4, lines 20-30; column 10, lines 47-51.

Nothing in these patents teaches or suggests that a combination of polyquaternium-10 cationic polysaccharide and glucose or α -methyl gluco-pyranoside can impart an unexpected antimicrobial property to a solution, as unexpectedly discovered by Applicant and shown by the data disclosed in the instant specification. Such an antimicrobial property of this combination cannot be inferred by a reading of these patents. In other words, a reason cannot be identified that would have prompted a person of ordinary skill in the art of ophthalmic solution to combine polyquaternium-10 cationic polysaccharide and glucose or α -methyl gluco-pyranoside for achieving the preservative efficacy as recited in the amended claims.

Serial No. 10/725,159

Since a combination of the '133 Patent and the '606 Patent does not provide a reason for combining the elements of claims 4, 7, 9-12, 20, and 21, these claims are not rendered obvious by the '133 Patent in view of the '606 Patent.

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of the claims at an early date is solicited.

Respectfully submitted,



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